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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,009	12/19/2001	Jason S. Felsch	111025.173	3244

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EXAMINER

SHIBUYA, MARK LANCE

ART UNIT PAPER NUMBER

1639

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/029,009	Applicant(s) FELSCH ET AL.	
	Examiner Mark L. Shibuya	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 21-36, 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20, 37 and 38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-40 are pending.
2. Applicant's election without traverse of Group I, claims 1-20, 37 and 38, and the species of hydrophobic target protein SEQ ID NO: 7, epitope tag SEQ ID NO: 29, and polar liquid, in the reply entered 12/3/2004, is acknowledged.
3. Claims 21-36, 39 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/3/2004.
4. Upon further consideration, the species requirement, mailed 10/1/2004, is withdrawn and replaced by a new species requirement for Group I, as present below.

Election of Species

5. This application contains claims directed to the following patentably distinct species of the claimed invention: Exposure under (a) homogeneous solution phase conditions (as in claims 2 and 37) or (b) heterogeneous solution phase conditions (as in claims 3 and 38).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no

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generic claim is finally held to be allowable. Currently, claims 1-3, 37, 38 are generic.

6. This application contains claims directed to the following patentably distinct species of the claimed invention: A hydrophobic target protein that is (a) a membrane protein, (b) an integral membrane protein, (c) a transmembrane protein, (d) a monotopic membrane protein, (e) a polytopic membrane protein, (f) a pump protein, (g) a channel protein, (h) a receptor kinase protein, (i) a G protein-coupled receptor protein, (j) a membrane-associated enzyme, or (k) a transporter protein.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 5, 12, 13, 37 and 38 are generic.

7. This application contains claims directed to the following patentably distinct species of the claimed invention: a multiplicity of molecules that are a mass-coded library (as in claim 6) and a multiplicity of molecules that are not a mass-coded library (as in claim 7).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 6 and 7 are generic.

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8. This application contains claims directed to the following patentably distinct species of the claimed invention: an amphiphile that is (a) a polar lipid, (b) an amphiphilic macromolecular polymer, (c) a surfactant or detergent, or (d) an amphiphilic polypeptide.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 8, 37, 38 are generic.

9. This application contains claims directed to the following patentably distinct species of the claimed invention: A tag sequence that is (a) a FLAG tag (NH₂-DYKDDDDK-COOH) (SEQ ID NO: 1), (b) an EE tag (NH₂-EEEEYMPME-COOH) (SEQ ID NO: 2), (c) a hemagglutinin tag (NH₂-YPYDVPDYA-COOH) (SEQ ID NO: 3), (d) a myc tag (NH₂-KHKLEQLRNSGA-COOH) (SEQ ID NO: 4), or (e) an HSV tag (MK-QPELMEDPED-COOH) (SEQ ID NO: 5).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12, 14 are generic.

10. This application contains claims directed to the following patentably distinct species of the claimed invention: a hydrophobic target protein with an

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order that comprises (a) Tag1-Tag2-HP, (b) Tag1-HP-Tag2, or (c) HP-Tag1-Tag2.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12, 15 are generic.

11. This application contains claims directed to the following patentably distinct species of the claimed invention: A hydrophobic target protein that is (a) Myc tag-EE tag-Human m2 mAChR (SEQ ID NO: 7), (b) Flag tag-Human Beta 2 Adrenergic Receptor EE tag (SEQ ID NO: 8), (c) Human Neurokinin 3 Receptor-HSV tag-Myc tag (SEQ ID NO: 9), (d) Flag tag-Human m1 mAChR-EE tag (SEQ ID NO: 10), or (e) Rat m3 mAChR-HSV tag-OctaHis tag (SEQ ID NO: 11).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12, 15, 16 are generic.

12. This application contains claims directed to the following patentably distinct species of the claimed invention: A heterologous signal sequence that is (a) the Mellitin signal sequence of NH₂-KFLVNVALVFMVVYISYIYA-COOH (SEQ ID NO: 12), (b) the GP signal sequence of NH₂-VRTAVLILLVRFSEP-COOH (SEQ ID NO: 13), (c) the Hemagglutinin signal sequence of NH₂-

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KTIIALSYIFCLVFA-COOH (SEQ ID NO: 14), (d) the rhodopsin tag 1 signal sequence of NH2- MNGTEGPNFYVPFSNKTGVVRSPFEAQYYLAEP-COOH (SEQ ID NO: 15), or (e) the rhodopsin tag ID4 signal sequence of NH2- GKNPLGVRKTETSQVAPA-COOH (SEQ ID NO: 16).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12, 15, 17, 18 are generic.

13. This application contains claims directed to the following patentably distinct species of the claimed invention: tag sequences further comprising a hexahistidine sequence (SEQ ID NO: 17) or a decahistidine sequence (SEQ ID NO: 18).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12, 15, 17, 18, 19 are generic.

14. This application contains claims directed to the following patentably distinct species of the claimed invention: (a) GP67 SS-Myc tag-EE tag-Human m2 mAChR (SEQ m NO: 19), (b) Mellitin SS-Flag tag-Human Beta 2 Adrenergic Receptor-EE tag (SEQ ID NO: 20), (c) Hemagglutinin SS-Human Neurokinin 3 Receptor-HSV tag-Myc tag (SEQ ID NO: 21), (d) Mellitin SS-Flag tag-Human m1

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mAChR-EE tag (SEQ ID NO: 22), or (e) Hemagglutinin SS-Rat m3 mAChR-HSV tag-OctaHis tag (SEQ ID NO: 23).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12, 15, 17, 18, 20 are generic.

15. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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16. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


17. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark L. Shibuya
Examiner
Art Unit 1639

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